

TTAB

In re Application Serial No. : 75955458

For the Mark : EHOSES.COM A DIVISION OF AC SUPPLY, INC.
INNOVATORS IN HOSE TECHNOLOGY AND
INVENTORY MANAGEMENT

Filed : March 8, 2000

**Published in the Trademark
Official Gazette on :** October 16, 2001



12-12-2001

U.S. Patent & TMO/c/TM Mail Rpt Dt. #11

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Ehose.com, Inc., :
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Opposer, :
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v. :
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AC Supply, Inc., :
:
Applicant. :
-----X

Opposition No.

01 DEC 18 AM 9:30

BOX TTAB—FEE
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

NOTICE OF OPPOSITION

by: e-Hoses.com, Inc.
17 Charles Street
Old Lyme, Connecticut 06371

A duplicate copy of this Notice of Opposition is enclosed.

FEE: \$200.00

The above-identified opposer believes that it will be damaged by registration of the mark shown in the above-identified application and hereby opposes same.

The grounds for the opposition are:

1. The mark is generic and merely descriptive under §2(e)(1) of the Trademark Act.

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2. Likelihood of confusion with a common law mark and trade name under §2(d) of the Trademark Act.

I. OVERVIEW

The applicant has filed an intent to use application to request registration of the following mark.¹

*EHOSES.COM A DIVISION OF AC SUPPLY, INC. INNOVATORS IN HOSE
TECHNOLOGY AND INVENTORY MANAGEMENT*

“A Division of”, “Supply, Inc.” and “Hose Technology and Inventory Management” have all been disclaimed by applicant leaving “EHOSES.COM”, “AC” and “INNOVATORS IN” as the intended registrable components of the mark under 15 U.S.C. §1056, T.M.E.P. §1213. As each of these components is merely descriptive, it should be refused registration. Horlick’s Malted Milk Co. v. Borden Co., 295 F. 232, 234, 1924 C.D. 197, 199 (D.C. Cir. 1924).

“AC” is merely a surname and is unregistrable under §2(e)(4) of the Trademark Act, 15 U.S.C. §1052. Similarly, “INNOVATORS IN” is merely a descriptive slogan and is similarly unregistrable. *See, In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984) (AMERICA’S FRESHEST ICE CREAM for flavored ices, etc., held incapable of distinguishing applicant’s goods and unregistrable); *In re Wakefern Food Corp.*, 222 USPQ 76 (TTAB 1984) (WHY PAY MORE! held to be an unregistrable common commercial phrase).

Therefore, the only potentially registrable component of the mark would be EHOSES.COM and as will be demonstrated below, that component is similarly unregistrable.

II. “EHOSES.COM” is generic and merely descriptive under Section 2(e)(1).

A mark is merely descriptive under Trademark Act Section 2(e)(1), 15 U.S.C. 1052(e)(1), if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant services. *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); *In re Bed & Breakfast Registry*, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); *In re MetPath Inc.*, 223 USPQ 88 (TTAB 1984); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979); TMEP section 1209.01(b).

In the present case, the relevant services consist of “wholesale distributorship services and retail store services in the field of industrial hose; inventory control for others.” For these services, the applicant applied to register EHOSES.COM as a component of the mark identified above.

The definitions of the prefix “e-,” include:

Electronic-; the “e-dash” prefix may be attached to anything that has moved from paper to its electronic alternative such as e-mail, e-cash, etc. *The Computer Glossary* (8th ed. 1998).

¹ Specifically, as no Amendment to Allege Use has been filed in support of the Intent to Use application, opposer is requesting that the Notice of Allowance should not be issued.

The Board has ruled that the term “e-“ when used as a prefix has generally recognized meaning of electronic in terms of computers and the Internet. The Board has further indicated that when the “e-” prefix is coupled with a descriptive word, the resulting whole is merely descriptive of specified goods and/or services. *See, In re Styleclick.com Inc.*, 57 USPQ2d 1445, 1448 (TTAB 2000)(E-FASHION descriptive of electronic retailing services featuring fashions).

According to the Board,

The intent of Section 2(e)(1) is to protect the competitive needs of others, that is, “descriptive words must be left free for public use.” *In re Colonial Stores, Inc.*, 394 F.2d 549, 157 USPQ 382, 383 (CCPA 1968). As the Internet continues to grow, merely descriptive “e-“ prefix terms for Internet related goods and/or services must be kept available for competitive use by others. *Id.*

The applicant’s recitation of services and specimen clearly indicate that the applicant offers its hose products via the Internet. Consumer’s encountering the term E-HOSE would immediately understand that the applicant provided Internet related services featuring hoses. As such, this applicant’s generic and merely descriptive mark should not be registered.

III. Likelihood of confusion with a common law mark and trade name under Section 2(d).

A use that has not yet risen to the status of a trademark or service mark, may, however, be sufficient to maintain a successful opposition. *Chatam International Inc. v. Abita Brewing Co.*, 49 U.S.P.Q.2d 2021, 2023 (TTAB 1998) (unpublished) (“As a general rule, use analogous to trademark use is sufficient to create a proprietary right in the user for purposes of a likelihood of confusion claim”). In determining the likelihood of confusion under §2(d), the PTO uses a multi-factor test originally enumerated by the CCPA in 1973. *In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563 (CCPA 1973). The elements are not listed in order of merit and each may from case to case play a dominant role. *In re E.I. DuPont DeNemours & Co.*, 177 U.S.P.Q. 563, 566-67 (CCPA 1973).

Applicant’s intended services consist of “wholesale distributorship services and retail store services in the field of industrial hose; inventory control for others.” Opposer’s services consist of distribution and manufacturer of industrial and commercial hoses, hose fittings, couplings, and accessories, including an Internet based business to business platform for the sales thereof. Opposer has been using the trade-name e-hose.com in commerce since April 28, 1999. As the subject application is intent to use and no amendment to allege use has been filed, the applicant has not yet even used this mark in commerce. The opposer has spent significant resources registering its domain name and establishing its website (see, www.ehose.com).

Based upon the intended use of the applicant and the current use of the opposer, the following Dupont factors are submitted for consideration.

1. *The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.*

Despite applicant's lengthy proposed name in its application, this case boils down to e-hose.com v. ehoses.com. The similarity of their marks as to appearance, sound, connotation and commercial impression are completely self-evident.

2. *The similarity or dissimilarity and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.*

Both the applicant and opposer distribute and manufacture commercial and industrial hoses.

3. *The similarity or dissimilarity of established, likely to continue, trade channels.*

As the applicant and opposer each intend to market itself as an Internet supplier of hoses, the continued and future trade channels are likely to be similar.

4. *The conditions under which buyers to whom sales are made, i.e., impulse vs. careful, sophisticated purchasing.*

Purchasers will be businesses both seeking to fill long-term needs as well as providing emergency equipment on short notice. Therefore, there may be impulse buyers thus increasing the likelihood for confusion.

5. *The fame of the prior mark (sales, advertising, length of use).*

The applicant's mark has no fame as it has not yet been used in commerce by the applicant.

6. *The number and nature of similar marks on similar goods*

The opposer is unaware of any other "e-hose" named competitor.

7. *The nature and extent of any actual confusion.*

The opposer is unaware of any actual confusion which has occurred, again because the applicant has not yet used the mark in commerce.

8. *The length of time during and the conditions under which there has been concurrent use without evidence of actual confusion.*

Again, as applicant has not used the product, there has been no concurrent use.

9. *The extent of potential confusion, i.e., whether de minimus or substantial.*

Based on the similarity of the marks, there is substantial potential for confusion.

10. *The extent to which applicant has the right exclude others from use of its mark on its goods.*

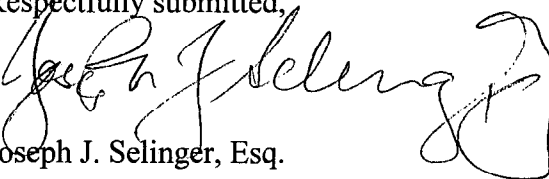
Oddly, it is likely that if this mark is registered, opposer would be able to exclude applicant from use of its mark. As indicated above, Opposer has registered its domain name, www.ehose.com. The Anticybersquatting Consumer Protection Act, 15 U.S.C. §1125(d), only allows the owner of a trademark to take legal action against a person if the confusingly similar mark of the trademark owner was distinctive *at the time of registration of the domain name*. As the applicant's mark was not even used in commerce at the time of registration, it clearly could not be found to be distinctive at the time of registration. Therefore, if a Notice of Allowance and ultimate registration is allowed, the applicant would have the trademark name, but NOT the right to exclude the opposer from using the almost identical name for its domain name. Furthermore, opposer would have an excellent argument to exclude applicant's use of its trademark on the Internet through the ICANN Uniform Dispute Resolution Policy. At a minimum, it is clear the applicant would not be allowed to exclude opposer from using the domain name.

As such, the applicant's mark is confusingly similar with a common law mark and therefore should not be granted a Notice of Allowance or ultimate registration.

IV. Conclusion

The proposed mark should be disallowed as being merely descriptive under §2(e)(1) and because there is a likelihood of confusion with a common law mark under §2(d).

Respectfully submitted,



Joseph J. Selinger, Esq.

Enclosures